

AO 120 (Rev. 2/99)

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
---	---

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District California on the ☐ Patents or ☒ Trademarks:

DOCKET NO. CV 12-06319 JCS	DATE FILED 12/12/2012	U.S. DISTRICT COURT 450 Golden Gate Avenue, 16 th Floor, San Francisco CA 94102
PLAINTIFF PEBBLE BEACH CO		DEFENDANT DYNASTY SPAS INC
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 22 Tms pgs. 3-4		***see attach complaint***
2		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Richard W. Wieking	(BY) DEPUTY CLERK Gina Agustine-Rivas	DATE December 16, 2012
-----------------------------	--	---------------------------

Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

COPY

1 TERRENCE MCMAHON (Cal. Bar No. 71910)
2 PHILIP OU (Cal. Bar. No. 259896)
3 McDERMOTT, WILL & EMERY LLP
275 Middlefield Rd.
4 Menlo Park, California 94025
Telephone: (650) 815-7400
Facsimile: (650) 815-7401
tmcMahon@mwe.com, pou@mwe.com

5 JOHN J. DABNEY (to file *pro hac vice* application)
6 MARY D. HALLERMAN (to file *pro hac vice*
application)
7 McDERMOTT WILL & EMERY LLP
500 North Capitol Street
8 Washington, D.C. 20001
Telephone: (202) 756-8000
9 Facsimile: (202) 756-8087
jdabney@mwe.com, mhallerman@mwe.com

10 *Attorneys for Plaintiff Pebble Beach Company*

11
12 UNITED STATES DISTRICT COURT
13 NORTHERN DISTRICT OF CALIFORNIA
14

15 PEBBLE BEACH COMPANY, a
16 California General Partnership,

17 Plaintiff.

18 v.

19 DYNASTY SPAS INC., a Tennessee
Corporation,

20 Defendant.

C 12 6319
CASE NO. _____

COMPLAINT FOR TRADEMARK
INFRINGEMENT, UNFAIR COMPETITION,
TRADEMARK DILUTION AND FALSE
DESIGNATION OF ORIGIN

DEMAND FOR JURY TRIAL

21 Plaintiff Pebble Beach Company ("Plaintiff"), for its Complaint against Defendant
22 Dynasty Spas Inc. ("Defendant"), alleges as follows:
23

24 THE PARTIES

25 1. Plaintiff is a California general partnership having its principal place of business in
26 the County of Monterey, California.
27
28

FAXED

2. Plaintiff owns the most famous golf resort in the United States, the Pebble Beach golf resort. Plaintiff owns numerous federally registered marks for PEBBLE BEACH for a variety of goods and services, including for golfing services, resort services and spa services.

3. Defendant is a Tennessee corporation, having its principal place of business at 101 Dynasty Way, Athens, Tennessee 37303. Defendant is using Plaintiff's famous and federally registered PEBBLE BEACH mark to advertise, promote and sell spas.

JURISDICTION AND VENUE

4. This is an action for trademark infringement, unfair competition, false designation of origin and trademark dilution under the Lanham Act, 15 U.S.C. §§ 1051, *et seq.* and California law.

5. This Court has subject matter jurisdiction over Plaintiff's claims under 28 U.S.C. §§ 1331, 1332 and 1338(a). This Court has supplemental jurisdiction over Plaintiff's state law claims under 28 U.S.C. § 1367.

6. This Court has personal jurisdiction over Defendant. Defendant conducts business in this district, solicits customers in this district and has dealers that conduct business in this district. On information and belief, Defendant has sold or caused others to sell infringing products and distribute infringing advertising in this district. Defendant's website **dynastyspas.com** advertises Defendant's PEBBLE BEACH products and is available to individuals in this district. Defendant's web site features a 1-800 number which customers in this district can use to contact Defendant about its PEBBLE BEACH spas. Defendant's website lists several distributors located in California, including one or more distributors that serve this district. On information and belief, Defendant targets this judicial district to sell its PEBBLE BEACH products. Defendant's unlawful conduct expressly targeted Plaintiff, who Defendant knew was located in this district and Defendant knew would suffer injury in this district. Venue is proper under 28 U.S.C. § 1391.

Plaintiff and Its Famous PEBBLE BEACH Trademarks

7. In 1919, Plaintiff opened a golf course and resort, which it called "Pebble Beach."

1 8. Plaintiff has hosted many major golf championships at its Pebble Beach golf
2 course, including the "U.S. Open" in 1972, 1982, 1992, 2000, and 2010.

3 9. Plaintiff's Pebble Beach golf course is consistently ranked among the greatest golf
4 courses by trade publications and others in the golf industry. *Golf Magazine* has proclaimed the
5 Pebble Beach golf course as the greatest golf course in the world. *Golf Digest* has ranked Pebble
6 Beach as the No. 1 golf course in the United States.

7 10. For decades, professional golf and travel writers and others have written thousands
8 of unsolicited articles in major golf, general interest, and travel magazines, as well as in books,
9 highlighting the storied golf history of Plaintiff's Pebble Beach golf course and resort.

10 11. Plaintiff has owned and operated The Spa at Pebble Beach since 1993. The Spa
11 enjoys a widespread reputation in its marketplace as a premier spa destination, earning accolades
12 by *Travel + Leisure Golf*, 2006, for Best [Spa] in the West/Northwest; *Condé Nast Traveler*,
13 2007, Top 50 North American Resort Spas; *Travel + Leisure Magazine*, 2008, #3 World's Best
14 Hotel Spa; and most recently in 2012, the Spa was the recipient of a Four-Star Award by *Forbes*
15 *Travel Guide*.

16 12. Plaintiff has invested substantial sums of money to advertise and promote goods
17 and services under its PEBBLE BEACH marks.

18 13. Plaintiff owns common law and federally registered marks for PEBBLE BEACH
19 for a variety of products and services, including golf course facilities, resort services, spa
20 services, and hotel and restaurant services. *E.g.*, U.S. Trademark Reg. Nos. 768,208; 1,065,027;
21 1,571,563; 1,605,005; 1,724,418; 1,806,360; 1,884,513; 2,457,508; 3,466,613; 3,604,966, among
22 others. (Collectively Plaintiff's PEBBLE BEACH common law and federally registered marks
23 are referred to as Plaintiff's "PEBBLE BEACH Marks.")

24 14. Plaintiff's PEBBLE BEACH Marks are famous and were so long before the
25 conduct complained of in this Complaint.

1 **Facts Giving Rise to Plaintiff's Claims**

2 15. Despite Plaintiff's long-established rights in Plaintiff's PEBBLE BEACH Marks,
3 Defendant commenced use of the mark PEBBLE BEACH to advertise, promote and sell spas.
4 *See, e.g.,* Ex. A.

5 16. Defendant and Defendant's distributors sell the PEBBLE BEACH spa under their
6 "Club Series," which features the spa advertised against the background of a golf course. *See,*
7 *e.g.,* Ex. A. The other spas in Defendants' "Club Series" are also named after well-known golf
8 courses or golf resorts. *See, e.g.,* Ex. B.

9 17. On November 6, 2012, Plaintiff sent Defendant a cease and desist letter.
10 demanding that Defendant cease use of Plaintiff's PEBBLE BEACH Marks.

11 18. Despite Defendant's receipt of Plaintiff's letter, Defendant and its dealers continue
12 to use Plaintiff's PEBBLE BEACH Marks, including on Defendant's web site and on the web
13 sites of its various dealers throughout the United States. *See, e.g.,* Exs. A and B.

14 19. Defendant's actions are knowing, willful, and deliberate, and done with the intent
15 to trade off the goodwill and reputation associated with Plaintiff's PEBBLE BEACH Marks.

16 **COUNT I**

17 **TRADEMARK INFRINGEMENT, UNFAIR COMPETITION AND FALSE**
18 **DESIGNATION OF ORIGIN UNDER THE LANHAM ACT (15 U.S.C. §§ 1114, 1125)**

19 20. Plaintiff realleges and incorporates each and every allegation contained in the
20 paragraphs above as though fully set forth herein.

21 21. Plaintiff owns numerous federally registered and common law marks for PEBBLE
22 BEACH for a variety of goods and services, including golf services and spa services. *E.g.,* U.S.
23 Trademark Reg. Nos. 1,028,939; 1,065,027; 1,724,418; 1,738,373; 1,765,946; 1,767,424;
24 1,776,631; 1,806,360; 2,844,431; 3,466,613; 3,530,929 and 3,538,302.

25 22. Defendant is using marks identical and substantially identical to Plaintiff's
26 federally registered PEBBLE BEACH Marks to offer for sale and sell products, including spas.

27 23. Defendant's unauthorized use of Plaintiff's PEBBLE BEACH Marks constitutes
28 trademark infringement, unfair competition and false designation of origin in violation of 15

1 U.S.C. §§ 1114 and 1125, because such conduct is likely to cause confusion, mistake or deception
2 as to source, origin, affiliation, connection or association of Defendant's products.

3 24. Defendant's acts have caused Plaintiff to lose control over the reputation and
4 goodwill associated with Plaintiff's PEBBLE BEACH Marks.

5 25. Plaintiff has suffered damages and Defendant has obtained profits and/or unjust
6 enrichment as a result of Defendant's wrongful conduct.

7 26. Defendant's acts irreparably injure Plaintiff's business, reputation and goodwill.
8 Unless Defendant is enjoined from its wrongful conduct, Plaintiff will continue to suffer
9 irreparable injury and harm, for which Plaintiff has no adequate remedy at law.

10 **COUNT II**
11 **TRADEMARK DILUTION UNDER THE LANHAM ACT (15 U.S.C. § 1125(c))**

12 27. Plaintiff realleges and incorporates each and every allegation contained in the
13 paragraphs above as though fully set forth herein.

14 28. Plaintiff's PEBBLE BEACH marks for golfing, resort and spa services are
15 "distinctive" and "famous" within the meaning of 15 U.S.C. § 1125(c)(1).

16 29. Defendant commenced use of Plaintiff's PEBBLE BEACH Marks after those
17 marks had become distinctive and famous.

18 30. Defendant's unauthorized use of Plaintiff's PEBBLE BEACH Marks is likely to
19 dilute Plaintiff's famous PEBBLE BEACH marks by impairing the distinctiveness of those
20 marks, in violation of 15 U.S.C. § 1125(c).

21 31. Defendant's acts irreparably injure Plaintiff's business, reputation and goodwill.
22 Unless Defendant is enjoined from its wrongful conduct, Plaintiff will continue to suffer
23 irreparable injury and harm, for which Plaintiff has no adequate remedy at law.

24 **COUNT III**
25 **TRADEMARK INFRINGEMENT, UNFAIR COMPETITION AND FALSE**
26 **DESIGNATION OF ORIGIN UNDER CALIFORNIA LAW**

27 32. Plaintiff realleges and incorporates each and every allegation contained in the
28 paragraphs above as though fully set forth herein.

33. Defendant's unauthorized use of PEBBLE BEACH constitutes trademark infringement, unfair competition, and false designation of origin, in violation of California common law and California Business & Professions Code § 17200, because it is likely to cause confusion, mistake or deception as to source, origin, affiliation, connection or association.

34. Defendant's acts have caused Plaintiff to lose control over the reputation and goodwill associated with Plaintiff's PEBBLE BEACH Marks.

35. Plaintiff has suffered damages and Defendant has obtained profits and/or unjust enrichment as a result of Defendant's wrongful conduct.

36. Defendant's acts irreparably injure Plaintiff's business, reputation and goodwill. Unless Defendant is enjoined from its wrongful conduct, Plaintiff will continue to suffer irreparable injury and harm, for which Plaintiff has no adequate remedy at law.

COUNT IV
CALIFORNIA TRADEMARK DILUTION (CAL. BUS. & PROF. CODE §14330)

37. Plaintiff realleges and incorporates each and every allegation contained in the paragraphs above as though fully set forth herein.

38. Plaintiff's PEBBLE BEACH Marks are distinctive and famous within the meaning of California Business and Professions Code § 14330.

39. Defendant commenced use of Plaintiff's PEBBLE BEACH Marks after those marks had become famous and distinctive.

40. Defendant's unauthorized use of PEBBLE BEACH is diluting and is likely to dilute Plaintiff's famous PEBBLE BEACH Marks, by impairing the distinctiveness of those marks, which constitutes injury to business reputation and/or dilution in violation of California Business and Professions Code § 14330.

41. Defendant's acts irreparably injure Plaintiff's business, reputation and goodwill. Unless Defendant is enjoined from its wrongful conduct, Plaintiff will continue to suffer irreparable injury and harm, for which Plaintiff has no adequate remedy at law.

- 1
- 2
- 3
- 4
- 5
- 6
- 7
- 8
- 9
- 10
- 11
- 12
- 13
- 14
- 15
- 16
- 17
- 18
- 19
- 20
- 21
- 22
- 23
- 24
- 25
- 26
- 27
- 28

2
3

- 4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27

- 1 c. a trebling of the damages awarded to Plaintiff and an enhanced award of
2 Defendant's profits to Plaintiff, as provided for by 15 U.S.C. §1117(a);
3 d. Plaintiff's costs and reasonable attorneys' fees pursuant to 15 U.S.C. §
4 1117(a) and California common and statutory law; and
5 e. punitive or exemplary damages, as permitted by California law.

6 4. That this Court grant Plaintiff such other and further relief, in law or in equity, as it
7 should deem just and proper.

8 **JURY DEMAND**

9 Plaintiff respectfully demands a trial by jury on all claims and issues so triable.

10

11 Dated: December 12, 2012

Respectfully submitted,

12

McDERMOTT WILL & EMERY LLP

13

By: 

14

Terrence McMahon

Philip Ou

15

McDERMOTT WILL & EMERY LLP

275 Middlefield Road, Suite 100

16

Menlo Park, CA 94025

Telephone: (650) 815-7400

17

Facsimile: (650) 815-7401

18

tcmahon@mwe.com

pou@mwe.com

19

20

John J. Dabney (*pro hac vice pending*)

Mary D. Hallerman (*pro hac vice pending*)

21

McDERMOTT WILL & EMERY LLP

500 North Capitol Street

22

Washington, D.C. 20001

Telephone: (202) 756-8000

23

Facsimile: (202) 756-8087

24

jdabney@mwe.com

mhallerman@mwe.com

25

26

Attorneys for Plaintiff

PEBBLE BEACH COMPANY

27

DM_US 40261148-1.070166.0349

28